

Application No. 10/804,210
Amendment Dated February 22, 2006
Reply to Office Action of November 22, 2005

REMARKS/ARGUMENTS:

Claims 1, 2 and 4 – 22 are pending in the application, with claims 1, 12 and 20 being independent. No new matter has been added.

Applicants have carefully considered the contents of the Office Action and respectfully request reconsideration and reexamination of the subject application in view of the explanations noted below.

Basis for Rejection of Claims 1, 2, 4, 6 – 9, 11 – 17, 19 - 20 and 22

The statutory basis for the rejection of claims 1, 2, 4, 6 – 9, 11 – 17, 19 - 20 and 22 is unclear. The heading for the section (at the top of page 2) indicates that the rejection is under 35 U.S.C. § 103. The second paragraph stating the rejection under the “Claim Rejections - 35 USC § 103” heading states that the claims are rejected under 35 U.S.C. § 103(a). However, the immediately following paragraph applying U.S. Patent No. 5,494,457 to Kunz (the Kunz ‘457 patent) states that the rejection is under “35 U.S.C. § 102(b).” Thus, due to the confusion regarding the statutory basis for the rejection of claims 1, 2, 4, 6 – 9, 11 – 17, 19 - 20 and 22, arguments are presented for both 35 U.S.C. §§ 102(b) and 103(a) rejections.

Rejection under 35 U.S.C. § 102(b)

Claims 1, 2, 4, 6 – 9, 11 – 17, 19 - 20 and 22 are rejected under 35 U.S.C. § 102(b) as being anticipated by the Kunz ‘457 patent. Applicants respectfully traverse this rejection, since the Kunz ‘457 patent clearly does not disclose, teach or render obvious the subject matter of independent claims 1, 12 and 20.

Independent claims 1, 12 and 20 recite, inter alia, a rib extending outwardly from a latch beam and first and second ears having a portion tapering toward the rear end of a connector housing.

The November 22, 2005 alleges that one of the embodiments of the Kunz ‘457 patent discloses an embodiment in which the plug is formed unitarily with wings (ears) and col. 1, lines 32 – 36 of the Kunz ‘457 patent is cited for support. However, this embodiment noted in the background of the Kunz ‘457 is merely an example of a prior art solution and is not shown in any drawings of the Kunz ‘457 patent. The description of the prior art solution at

col. 1, lines 32 – 36 does not disclose many features of the independent claims 1, 12 and 20, such as a rib extending outwardly from the latch beam and the first and second ears having a portion tapering toward the rear end of the connector housing. No further description of this prior art solution is provided anywhere else in the Kunz '457 patent.

Furthermore, the disclosed embodiments of the invention of the Kunz '457 patent do not disclose first and second ears unitarily formed with the connector housing as recited in independent claim 1. The disclosed embodiments of the invention of the Kunz '457 patent also do not disclose a rib extending outwardly from the latch beam and at least as high as the first and second ears from the upper surface of the connector housing as recited in independent claims 1 and 12.

Lacking several elements recited in claims 1, 12 and 20, the Kunz '457 patent does not anticipate claims 1, 12 and 20 since a "claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegall Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987). Therefore, the Kunz '457 patent does not anticipate independent claims 1, 12 and 20.

Claims 2, 4 – 11, 13 – 19 and 21 – 22, being dependent upon claims 1, 12 and 20, respectively, are also allowable for the above reasons. Moreover, these dependent claims recite additional features further distinguishing them over the cited patents, such as the connector being an RJ-45 plug of claims 2 and 13; the rib extending higher than the first and second ears of claim 4; a portion of the rib tapering toward a rear end of the latch beam of claims 10, 18 and 21; and the rib being unitarily formed with the latch beam of claims 11, 19 and 22. Therefore, dependent claims 2, 4 – 11, 13 – 19 and 21 – 22 are not anticipated by the cited patents, particularly within the overall claimed combination.

Rejections under 35 U.S.C. § 103(a)

Claims 1, 2, 4, 6 – 9, 11 – 17, 19 – 20 and 22 are rejected under 35 U.S.C. § 103(a) as being anticipated by U.S. Patent No. 5,494,457 to Kunz (the Kunz '457 patent). Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the Kunz '457 patent in view of U.S. Design Patent D477,571 to Huang et al. (the Huang '571 patent). Applicants

respectfully traverse this rejection, since the Kunz patent clearly does not disclose, teach or render obvious the subject matter of independent claims 1, 12 and 20.

Independent claim 1 recites, inter alia, first and second ears unitarily formed with a unitarily formed connector housing.

Independent claims 12 and 20 recite, inter alia, a rib extending outwardly from a latch beam at least as high as the first and second ears.

The Kunz '457 patent discloses a strain relief connector or boot 30 adapted to engage a plug 14 of *an existing connection*. Col. 1, lines 46 – 49. The boot 30 has wings 44 and 46 sized to extend *above and beyond* the free end 20 of the tab 18 to protect the tab from unwanted contact with any obstructions (col. 3, lines 37 – 47). Moreover, the wings 44 and 46 are “integral with the side walls” 36 and 38. Col. 3, lines 33 – 36. The boot 30 is *slidably disposed* on and separately formed from the plug 14, as shown in FIGS. 1 and 2. The wings 44 and 46 are integrally formed with the boot 30, as is clearly shown in FIG. 2.

The Huang '571 patent is cited for disclosing a rib (the gripped portion) that extends higher than the first and second ears, as shown in FIGS. 4 and 5.

Independent Claim 1

The Kunz '457 patent does not disclose nor render obvious first and second ears unitarily formed with a unitarily formed connector housing, as recited in independent claim 1.

The November 22, 2005 alleges that one of the embodiments of the Kunz patent discloses an embodiment in which the plug is formed unitarily with wings (ears) and col. 1, lines 32 – 36 of the Kunz '457 patent is cited for support. However, this citation refers to a disadvantageous solution of the prior art, *not* an embodiment disclosed or suggested by the Kunz '457 patent as stated in the November 22, 2005 Office Action. The Kunz '457 states that this prior solution is disadvantageous because this solution “does not lend itself to easily retrofitting existing cable systems since the plug must be replaced.” Thus, the Kunz '457 patent clearly teaches away from having the first and second ears being unitarily formed with the connector housing. Teaching away from the claimed invention is a per se demonstration of lack of prima facie obviousness as it is the antithesis of the reference suggesting that the

person of ordinary skill go in the claimed direction. In re Hedges, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986).

Furthermore, modifying the Kunz '457 patent such that the plug 14 and boot 30 are unitarily formed would not be obvious because it would destroy the above-noted advantage provided by the boot 30 of the Kunz '457 patent, i.e., easily retrofitting existing cable systems. A rejection based upon a modification of a reference that destroys the intent and function of the invention disclosed in the reference is not proper. There is no technological motivation for engaging in the suggested modification, rather there is a disincentive to modify the Kunz '457 patent as suggested. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Therefore, the Kunz '457 patent does not disclose or render obvious the claimed features of Applicants' invention as recited in independent claim 1, or its respective dependent claims 2 and 4 – 11. Furthermore, because the Huang '571 patent does not cure the deficiencies noted above with respect to independent claim 1, claim 5 is also allowable for the above reasons.

Claims 2 and 4 – 11, being dependent upon claim 1, are also allowable for the above reasons. Moreover, these dependent claims recite additional features further distinguishing them over the cited patents, such as the connector being an RJ-45 plug of claim 2; the rib extending higher than the first and second ears of claim 4; a portion of the rib tapering toward a rear end of the latch beam of claim 10; and the rib being unitarily formed with the latch beam of claim 11. Therefore, dependent claims 2 and 4 – 11 are not anticipated or rendered obvious by the cited patents, particularly within the overall claimed combination.

Independent Claims 12 and 20

The Kunz '457 patent does not disclose nor render obvious a rib extending outwardly from the latch beam and at least as high as the first and second ears from the upper surface of the connector housing, as recited in independent claims 12 and 20

As clearly shown in FIG. 4, the free end 20 of the tab 18, which the examiner cites as being the rib recited in independent claims 12 and 20, does not extend at least as high as the wings 44 and 46 of the Kunz '57 patent. Thus, the Kunz '457 patent does not disclose a rib

extending outwardly from a latch beam at least as high as the first and second ears, as recited in independent claims 12 and 20. “[T]he wings 44, 46 are sufficiently sized to extend above and beyond the free end 20 of the tab 18.” Col. 3, lines 37 – 41.

The Office Action cites the Huang ‘571 patent as disclosing a rib (the gripped portion) that extends higher than the first and second ears, as shown in FIGS. 4 and 5.

However, it would not be obvious to modify the free end 20 of the tab 18, as suggested in the Office Action, to be higher than the first and second ears because to do so would contravene the express teaching of the Kunz ‘457 patent. Moreover, the Kunz ‘457 patent clearly teaches away from having a rib extending at least as high as the first and second ears. The wings 44 and 46 of the Kunz ‘457 patent “are sufficiently sized to *extend above and beyond* the free end 20 of the tab 18 so as to engage any obstructions when pulling or snaking the cord 12 through a space thereby protecting the tab 14 from unwanted contact with the obstructions.” Col. 3, lines 37 – 41 (emphasis added). Modifying the wings 44 and 46 of the Kunz ‘457 patent as suggested in the Office Action would not only render the Kunz unsuitable for its intended purpose, but entirely ignores the clear intent of the Kunz ‘457 patent to have the wings extend above and beyond the free end of the tab. Thus, the Huang ‘571 patent cannot properly be combined with the Kunz ‘457 patent because to do so would destroy that on which the invention of the Kunz ‘457 patent is based. In re Hartmann, 186 USPQ 366 (PTO Bd. App. 1974).

Moreover, as noted above, a rejection based upon a modification of a reference that destroys the intent and function of the invention disclosed in the reference is not proper. There is no technological motivation for engaging in the suggested modification, rather there is a disincentive to modify the Kunz ‘457 patent with the teachings of the Huang ‘571 patent as suggested. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Thus, independent claims 12 and 20 are clearly not anticipated or rendered obvious by the Kunz ‘457 patent in view of the Huang ‘571 patent).

Therefore, the Kunz ‘457 patent in view of the Huang ‘571 patent does not disclose or render obvious the claimed features of Applicants’ invention as recited in independent claims 12 and 20, or their respective dependent claims 13 – 19 and 21 – 22.

Application No. 10/804,210
Amendment Dated February 22, 2006
Reply to Office Action of November 22, 2005

Claims 13 – 19 and 21 – 22, being dependent upon claims 12 and 20, respectively, are also allowable for the above reasons. Moreover, these dependent claims recite additional features further distinguishing them over the cited patents, such as the connector being an RJ-45 plug of claim 13; a portion of the rib tapering toward a rear end of the latch beam of claims 18 and 21; and the rib being unitarily formed with the latch beam of claims 19 and 22. Therefore, dependent claims 2, 4 – 11, 13 – 19 and 21 – 22 are not anticipated or rendered obvious by the cited patents, particularly within the overall claimed combination.

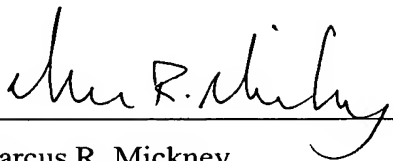
Allowable Subject Matter

Applicants appreciate the indicated allowability of objected to claims 10, 18 and 21, which would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

* * *

In view of the foregoing amendment and comments, Applicants respectfully submit that claims 1, 2 and 4 – 22 are in condition for allowance. Prompt and favorable action is solicited.

Respectfully Submitted,



Marcus R. Mickney
Reg. No. 44,941

Roylance, Abrams, Berdo & Goodman, L.L.P.
1300 19th Street, N.W., Suite 600
Washington, DC 20036
(202) 659-9076

Dated: February 22, 2006